III. Remarks

Claims 7, 17 and 19-30 were previously pending, with claims 1-6, 8-16 and 18 having been previously canceled without prejudice or disclaimer.

Claims 7, 17 and 19-30 were rejected in the Office Action mailed September 7, 2006.

Claims 7, 17 and 19-30 have been maintained in their previously-presented form.

As a result, claims 7, 17 and 19-30 are pending.

Reconsideration of claims 7, 17 and 19-30 in light of the following remarks is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

Claim 7

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 5,181,010 to Stout et al. ("Stout"). This rejection is respectfully traversed.

Claim 7 recites: A method of controlling the flow of fluidic materials within a tubular housing that defines an inlet passage and one or more outlet passages, comprising:

injecting fluidic materials into the inlet passage;

blocking the inlet passage;

conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage; and

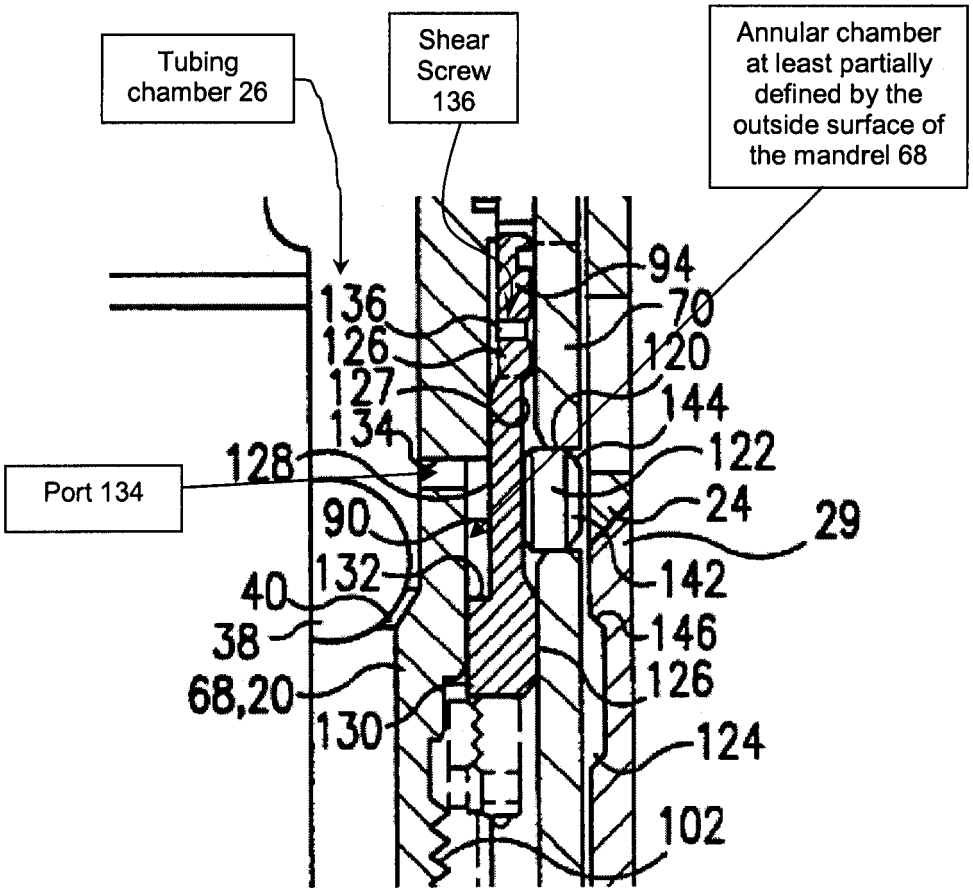
opening the outlet passages to permit fluidic materials within the inlet passage and the annular chamber to be conveyed out of the housing.

MPEP §2143.03 provides that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."

Here, in contrast to claim 7, Stout does not teach or suggest conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage; **and** opening outlet passages to permit fluidic materials within the inlet passage **and the annular chamber** to be conveyed out of the housing.

More particularly, Stout only teaches a port 134 that, under some conditions, is opened to permit fluid communication between the tubing chamber 26 and an annular chamber at least partially defined by the outside surface of the mandrel 68. However, any fluidic material, within

the tubing chamber 26 **and** the annular chamber at least partially defined by the outside surface of the mandrel 68, is **not** permitted to be conveyed out of any tubular housing, regardless of whether the shear screw 136 is broken or whether the port 134 permits fluid communication between the tubing chamber 26 and the annular chamber at least partially defined by the outside surface of the mandrel 68. *See* Stout, Figs. 4A, 4B and 5. A portion of Fig. 4B of Stout is shown below:



Portion of Fig. 4B of Stout

Since Stout does not teach or suggest all the limitations of claim 7, *prima facie* obviousness of claim 7 has not been established, and a rejection under 35 U.S.C. §103(a) over Stout is improper. Therefore, it is requested that the rejection of claim 7 under 35 U.S.C. §103(a) over Stout be withdrawn.

Claim 17

Claim 17 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 17 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Claim 19

Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 19 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Moreover, contrary to claim 19, Stout does not teach or suggest preventing debris from entering the annular chamber of claim 7. Instead, Stout only teaches a gravel screen 44 that is packed with gravel in preparation for producing oil from producing zone 42. *See* Stout, Figs. 1 and 2, and col. 5, lines 14-16. Therefore, claim 19 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 19 is in condition for allowance.

Claims 20 and 21

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claims 20 and 21 depend from, and further limit, claim 7 in a patentable sense and therefore are allowable for at least the same reasons as noted above with respect to claim 7.

Claim 22

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 22 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Moreover, contrary to claim 22, Stout does not teach or suggest controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidicly coupled to the outlet passages, as recited in claim 22, and therefore claim 22 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 22 is in condition for allowance.

Claim 23

Claim 23 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 23 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Claim 24

Claim 24 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 24 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Moreover, contrary to claim 24, Stout does not teach or suggest conveying the injected fluidic materials into a plurality of circumferentially spaced apart longitudinal valve chambers fluidicly coupled to corresponding outlet passages that each include corresponding movable valve members, as recited in claim 24, and therefore claim 24 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 24 is in condition for allowance.

Claim 25

Claim 25 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 25 depends from, and further limits, claim 24 in a patentable sense, and claim 24 depends from, and further limits, claim 7 in a patentable sense. Therefore, claim 25 is allowable for at least the same reasons as noted above with respect to claims 7 and 24.

Claim 26

Claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 26 depends from, and further limits, claim 24 in a patentable sense, and claim 24 depends from, and further limits, claim 7 in a patentable sense. Therefore, claim 26 is allowable for at least the same reasons as noted above with respect to claims 7 and 24.

Moreover, contrary to claim 26, Stout does not teach or suggest a method wherein the valve chambers are interleaved among the longitudinal passages, as recited in claim 26, and therefore claim 26 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 26 is in condition for allowance.

Claim 27

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 27 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Moreover, contrary to claim 27, Stout does not teach or suggest preventing debris from entering the annular chamber of claim 7. Instead, Stout only teaches a gravel screen 44 that is packed with gravel in preparation for producing oil from producing zone 42. *See* Stout, Figs. 1 and 2, and col. 5, lines 14-16. Therefore, claim 27 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 27 is in condition for allowance.

Claim 28

Claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 28 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Moreover, contrary to claim 28, Stout does not teach or suggest controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidicly coupled to the outlet passages, as recited in claim 28, and therefore claim 28 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 28 is in condition for allowance.

Claim 29

Claim 29 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. Claim 29 depends from, and further limits, claim 7 in a patentable sense and therefore is allowable for at least the same reasons as noted above with respect to claim 7.

Moreover, contrary to claim 29, Stout does not teach or suggest conveying the injected fluidic materials into a plurality of circumferentially spaced apart longitudinal valve chambers fluidicly coupled to corresponding outlet passages that each include corresponding movable valve members, as recited in claim 29, and therefore claim 29 further distinguishes over the prior art.

For the foregoing reasons, it is respectfully submitted that claim 29 is in condition for allowance.

Claim 30

Claim 30 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Stout. This rejection is respectfully traversed.

Claim 30 recites: A method for controlling the flow of fluidic materials within a tubular housing defining an inlet passage for conveying the fluidic materials into the housing and one or more outlet passages for conveying fluidic materials out of the housing, comprising:

injecting fluidic materials into the inlet passage;

blocking the inlet passage by placing a ball plug into a throat passage defined in the inlet passage;

conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing and surrounding the inlet passage;

preventing debris from entering the annular chamber;

detecting the operating pressure of the injected fluidic materials;

if the detected operating pressure of the injected fluidic materials exceeds about 500 to 3,000 psi, then displacing valve members positioned within corresponding longitudinal valve chambers defined in the tubular housing to thereby permit fluidic materials within the inlet passage to be conveyed radially out of the tubular housing through a plurality of outlet passages; and

controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidicly coupled to the outlet passages.

As discussed above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

Here, in contrast to claim 30, Stout does not teach or suggest conveying the injected fluidic materials radially out of the inlet passage into a plurality of spaced apart longitudinal passages defined in the tubular housing and into an annular chamber defined in the tubular housing that surrounds the inlet passage; **and** opening outlet passages to permit fluidic materials within the inlet passage **and the annular chamber** to be conveyed out of the housing. More particularly, Stout only teaches a port 134 that, under some conditions, is opened to permit fluid communication between the tubing chamber 26 and an annular chamber at least partially defined by the outside surface of the mandrel 68. However, any fluidic material, within the tubing chamber 26 **and** the annular chamber at least partially defined by the outside surface

of the mandrel 68, is **not** permitted to be conveyed out of any tubular housing, regardless of whether the shear screw 136 is broken or whether the port 134 permits fluid communication between the tubing chamber 26 and the annular chamber at least partially defined by the outside surface of the mandrel 68. *See* Stout, Figs. 4A, 4B and 5.

In further contrast to claim 30, Stout does not teach or suggest preventing debris from entering the annular chamber.

In further contrast to claim 30, Stout does not teach or suggest controlling the rate at which the fluidic materials are conveyed out of the tubular housing through the outlet passages using variable orifices positioned within and fluidicly coupled to the outlet passages.

Since Stout does not teach or suggest all the limitations of claim 30, *prima facie* obviousness of claim 30 has not been established, and a rejection under 35 U.S.C. §103(a) over Stout is improper. Therefore, it is requested that the rejection of claim 30 under 35 U.S.C. §103(a) over Stout be withdrawn.

Copy of Restriction Requirement

In lines 11-13 on page 2 of the Office Action mailed September 7, 2006, the Examiner repeats his request that Applicants provide a copy of the Office Action mailed October 2, 2001 in parent application no. 09/512,895 that sets forth a Restriction Requirement (hereinafter referred to as the "Restriction Requirement").

Applicants previously complied with the Examiner's request by including a copy of the Restriction Requirement with the Office Action response submitted on June 14, 2006. The submission of this document on June 14, 2006 is confirmed by the Image File Wrapper for this application which is available on the U.S. Patent and Trademark Office Patent Application Information Retrieval (PAIR) database. The document is found under the document description of "Transmittal of New Application."

Nevertheless, for the Examiner's convenience, enclosed is another copy of the Restriction Requirement.

Additional Requests and Comments by the Examiner

A. *The Examiner's request for a discussion of "those applications which are continuations/continuations-in-part and/or divisionals."*

In lines 3 and 4 on page 2 of the Office Action mailed September 7, 2006, the Examiner requests that Applicants:

> *discuss those applications which are continuations/continuations-in-part and/or divisionals.*

In response, Applicants note that the present application is a division of U.S. patent application serial number 09/512,895, now U.S. patent number 6,568,471, which is self-explanatory and requires no discussion. Applicants further note that the present application is neither a continuation nor a continuation-in-part of any other application.

Moreover, the above-quoted request is unclear as to whether the Examiner is requesting a discussion of any and all applications that are continuations, continuations-in-part or divisions of the present application. If the Examiner is requesting such a discussion, Applicants note that there is no requirement to do so and, to the extent that one or more applications are pending that are continuations, continuations-in-part or divisions of the present application, Applicants respectfully decline to discuss any of these pending applications.

B. *The Examiner's comment regarding the number of Information Disclosure Statements filed.*

In lines 13-16 on page 2 of the Office Action mailed September 7, 2006, the Examiner writes that:

> *Applicants now state that informational disclosure Statements (9) have been filed February 15, 2002, May 31, 2002, April 4, 2003, April 7, 2003, October 31, 2003, August 2, 2004, January 25, 2005, August 30, 2005, and January 31, 2006.*

In response, Applicants note that twenty-five (25) Information Disclosure Statements have been filed on nine (9) different dates, as summarized in the following table:

Date on which <u>one or more</u> Information Disclosure Statements were filed	**<u>Total</u> Number of Information Disclosure Statements filed on this date**	**Description of Information Disclosure Statement(s) filed on this date**
February 15, 2002	1	(1) IDS filed including (1) Form 1449 having (9) pages
May 31, 2002	1	(1) IDS filed including (1) Form 1449 having (6) pages
April 4, 2003	3	(3) IDSs filed (a) Electronic IDS having EFS ID no. 25655 (b) Electronic IDS having EFS ID no. 25658 (c) Electronic IDS having EFS ID no. 25660
April 7, 2003	1	(1) IDS filed including (1) Form 1449 having (1) page
October 31, 2003	2	(2) IDSs filed (a) Electronic IDS having EFS ID no. 50026 (b) IDS including (1) Form 1449 having (3) pages
August 2, 2004	6	(6) IDSs filed (a) (1) IDS including (1) Form 1449 having (4) pages (b) (1) IDS including (1) Form 1449 having (1) page (c) (1) IDS including (1) Form 1449 having (1) page (d) (1) IDS including (1) Form 1449 having (1) page (e) Electronic IDS having EFS ID no. 65736 (f) Electronic IDS having EFS ID no. 65713
January 25, 2005	5	(5) IDSs filed (a) (1) IDS including (1) Form 1449 having (2) pages (b) (1) IDS including (1) Form 1449 having (1) page (c) (1) IDS including (1) Form 1449 having (1) page (d) (1) IDS including (1) Form 1449 having (1) page (e) Electronic IDS having EFS ID no. 76653

Date on which one or more Information Disclosure Statements were filed	Total Number of Information Disclosure Statements filed on this date	Description of Information Disclosure Statement(s) filed on this date
August 30, 2005	5	(5) IDSs filed (a) (1) IDS including (1) Form 1449 having (1) page (b) (1) IDS including (1) Form 1449 having (1) page (c) (1) IDS including (1) Form 1449 having (4) pages (d) Electronic IDS having EFS ID no. 91612 (e) Electronic IDS having EFS ID no. 91613
January 31, 2006	1	(1) IDS filed including (12) single-page Form 1449s

C. The Examiner's request and comment regarding a supposed Information Disclosure Statement supposedly filed on May 31, 2003.

In lines 16 and 17 on page 2 of the Office Action mailed September 7, 2006, the Examiner requested that Applicants:

> *state the relevance/status of the May 31, 2003 statement (2 IDS) which was earlier stated to have [been] filed in the instant application.*

Moreover, in line 3 on page 3 of the Office Action mailed September 7, 2006, the Examiner writes that:

> *[t]he May 31, 2003 [Information Disclosure Statement], has not been received.*

In response, and referring to the table above, Applicants note that **NO** Information Disclosure Statements were filed on May 31, 2003 in the present application, notwithstanding any supposed statements to the contrary.

D. The Examiner's request regarding the documents cited in the previously-filed Information Disclosure Statements.

In lines 1-3 on page 3 of the Office Action mailed September 7, 2006, the Examiner writes that:

> *[a]pplicants are again asked to provide a discussion of the prior art deemed most relevant to the elected invention of Group X.*

Moreover, in lines 13-18 on page 3 of the Office Action mailed September 7, 2006, the Examiner writes that:

> *[t]he applicants compiled the documents and are in a much better position to easily determine those documents from their numerous IDS[s] filed [ ] which are relevant to the prosecution of the instant application. Until such reconsideration by applicants of [ ] what IDS[s] have been filed and the relevant documents in those numerous IDS[s], consideration of all IDS[s] by the examiner has been held in abeyance.*

In response, Applicants:

- have reconsidered what IDS[s] have been filed, as discussed above; and
- respectfully decline to provide a discussion of the prior art deemed most relevant to the elected invention of Group X for the same reasons provided in the Amendment filed on June 14, 2006, which are incorporated herein by reference, which include a discussion of the relevant sections of the MPEP, and which are provided below.

With respect to these reasons provided in the Amendment filed on June 14, 2006, in lines 11-13 on page 3 of the Office Action mailed September 7, 2006, the Examiner writes that:

> *Applicants' discussion of the relevant sections of the MPEP* [in the Amendment filed on June 14, 2006] *has been considered, however common sense and courtesy should prevail and the most relevant prior art from an extremely long list of documents should be discussed by the applicants* (emphasis added).

Applicants note that the above comment indicates that the Examiner has considered, ***but has completely disregarded***, Applicants' previously-filed discussion of the relevant sections of the MPEP, as discussed in the Amendment filed on June 14, 2006, in favor of a kind of general appeal to "common sense and courtesy."

In response, Applicants respectfully request that the Examiner fully reconsider the relevant sections of the MPEP with respect to the consideration of documents cited in Information Disclosure Statements, and indeed follow the guidelines presented therein. To this end, Applicants' discussion of the relevant sections of the MPEP, which includes the reasons why Applicants respectfully decline to provide a discussion of the prior art deemed most relevant to the elected invention of Group X, and which was included in Amendment filed on June 14, 2006, is provided below:

(1) The MPEP requires the Examiner to consider all of the cited references.

MPEP §609.05(b) provides that "[e]xaminers must consider all citations submitted in conformance with the rules." Therefore, the Examiner is required to consider all of the cited references that are in conformance with Title 37, Code of Federal Regulations.

(2) The request that Applicants discuss prior art deemed most relevant is not supported by any rule.

Applicants find no rule either in Title 37, Code of Federal Regulations, or in the MPEP, that requires Applicants to discuss prior art deemed most relevant, after Applicants have already identified and cited references in compliance with 37 CFR §1.56. Although the MPEP does suggest avoiding submitting long lists of documents if it can be avoided (*see* MPEP §2004 ¶13), Applicants respectfully note that this is only a "suggestion," rather than a requirement (*see* MPEP §2004, text immediately preceding ¶1), and, more importantly, Applicants respectfully submit that the amount of the cited references is a reflection of Applicants' efforts to fulfill the Duty of Disclosure. Further, Applicants respectfully note that the Examiner has not cited any rule in support of the request to discuss prior art deemed most relevant. Therefore, the Examiner is required to consider all of the cited references.

(3) Moreover, the request that Applicants discuss prior art deemed most relevant requires Applicants to make, and rely on, their own determinations of materiality, a course of action discouraged by the MPEP.

During its discussion of the Duty of Disclosure, MPEP §2001.04 expressly presumes that:

> *applicants will continue to submit information for consideration by the Office in applications rather than making and relying on their own determinations of materiality. An incentive remains to submit the information to the Office because it will result in a strengthened patent and will avoid later questions of materiality and intent to deceive (emphasis added).*

Moreover, MPEP §2001.05 indicates that:

> *[t]he Office believes that most applicants will wish to submit [ ] information, however, even though they may not be required to do so, to strengthen the patent and avoid the risk of an incorrect judgment on their part on materiality or that it may be held that there was an intent to deceive the Office (emphasis added).*

Here, if Applicants were to follow the Examiner's request and discuss prior art *already identified and cited* but now deemed most relevant, Applicants would be making a materiality determination. Thus, in full accordance with the MPEP, Applicants do not intend to make and rely on their own determinations of materiality, and further wish to avoid the risk of an incorrect judgment on their part on materiality. Therefore, the Examiner is required to consider all of the cited references.

In view of all of the above, Applicants respectfully petition the Examiner to consider all of the references cited in the previously-filed Information Disclosure Statements, and to take the necessary action to provide a clear record that all of the cited references have indeed been considered. *See* MPEP §609.05(b).

Conclusion

It is believed that all matters set forth in the Office Action mailed September 7, 2006 have been addressed. Applicants have made a diligent effort to advance the prosecution of this application by submitting arguments in support of the patentability of claims 7, 17 and 19-30.

In view of all of the above, the allowance of claims 7, 17 and 19-30 is respectfully requested.

Unless stated otherwise, any amendment to any claim was not made for reasons substantially related to the statutory requirements for patentability.

Furthermore, unless stated otherwise, any amendment to any claim was made to simply make express what had been implicit in the claim as originally worded and therefore none of the amendments to the claims is a narrowing amendment that would create any type of prosecution history estoppel. In addition, to the extent that any formerly dependent claim is now presented in independent form, such an amendment does not constitute a narrowing amendment that surrenders any subject matter.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

Randall C. Brown
Registration No. 31,213

Dated: 12/5/06

HAYNES AND BOONE, L.L.P.
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Telephone: (214) 651-5242
Facsimile: (214) 200-0853
File: 25791.76

Certificate of Service

I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on December 5th, 2006

Kathy Mettee

Kathy Mettee

Attachment: Copy of Office Action mailed October 2, 2001 for U.S. patent application no. 09/512,895

D-1485395_1.DOC

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/512,895	02/24/00	COOK	R 25791.12.02

EXAMINER	
NICHOLSON, E	
ART UNIT	PAPER NUMBER
3627	7

DATE MAILED: 10/02/01

PM82/1002

Todd Mattingly
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/512,895	COOK ET AL.	
	Examiner	Art Unit	
	Eric K Nicholson	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-16* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15)☐ Notice of References Cited (PTO-892)
16)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18)☐ Interview Summary (PTO-413) Paper No(s). _____ .
19)☐ Notice of Informal Patent Application (PTO-152)
20)☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1, drawn to coupling a member to a preexisting structure, classified in class 166, subclass 177.4.

II. Claims 3 and 16, drawn to an apparatus coupling a structure to an expanded member in product by process form classified in class 285, subclass 382.

III Claim 4, drawn to an apparatus for coupling with mating coupling arms, classified in class 285, subclass 322

IV Claims 2,5 and 15, drawn to a method for coupling, classified in class 29 subclass 428

V. Claims 6, 13 and 14, drawn to an apparatus for fluid control, classified in class 137, subclass 599.

VI. Claims 8, drawn to an apparatus having a piston in first and second chamber, classified in class 92 , subclass 61.

VII Claims 10 drawn to coupling a member to a preexisting structure, classified in class 166, subclass 208.

VIII. Claim 9, drawn to a method of applying an axial force, classified in class 29, subclass 888.

IX. Claim 11, drawn to a method of operating an apparatus, classified in class 184, subclass 6.

X. Claim 7, drawn to a method of controlling flow of, classified in class 137, subclass 1.

XI. Claim 12, drawn to an apparatus classified in class 285, subclass 61.

Inventions I ,II,III,V,VI,VII and XI are all related as product subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility from the remaining subcombinations since invention I requires use of a shoe coupled to the tubular member with a throat passage adapted to receive a wiper dart. Invention II has separate utility from the remaining subcombinations since invention II requires use of an expanded tubular member coupled to a preexisting structure. Invention III has separate utility from the remaining subcombinations since invention III

requires use of one or more support member slots and one or more tubular member slots. Invention V has separate utility from the other remaining subcombinations since invention V requires use of valve chambers, valve elements, a centralizer, a radial expansion assembly or a preload assembly. Invention VI has separate utility from the other subcombinations since invention VI requires use of an annular piston assembly in an annular chamber. Invention VII has separate utility from the other subcombinations since invention VII requires use of a body of lubricant positioned in an annular chamber defined by the space between a sealing member, an annular member and a tubular member. Invention XI has separate utility from the other subcombinations since invention XI requires use of a compressed spring coupled to the support member and a spacer to control the spring compression. See MPEP § 806.05(d).

Inventions IV, VIII, IX and X are all related as method subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility from the remaining subcombinations since invention IV requires use of injecting a first and second quantity of fluidic material above and below an expansion cone. Invention VIII has separate utility from the

remaining subcombinations since invention VIII requires use applying an axial force to a first piston using a second piston in a first piston chamber. Invention IX has separate utility from the remaining subcombinations since invention IX requires use of lubricating the interface between an expansion cone and a tubular member and applying a substantially constant axial force to the tubular member prior to beginning an expansion process. Invention X has separate utility from the remaining subcombinations since invention X requires use of injecting fluidic materials into an inlet passage and blocking a inlet passage and opening an outlet passage.

The inventions are distinct, each from the other because of the following reasons:

Inventions (IV,VIII,IX,X) and (I,II,III,V,VI,VII,XI) are related as process and apparatus for its practice or product made. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus or product made as claimed can be used to practice or be made by another and materially different process. (MPEP § 806.05(e)). In this case the processes as claimed can be practiced by another materially different apparatus or make materially different products.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Nicholson whose telephone number is (703) 308-0829. The examiner can normally be reached on Tuesdays thru Fridays from 7:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bethanne Dayoan, can be reached on (703) 308-3865. The fax phone number for Technical Center 3600 is (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technical Center receptionist whose telephone number is (703) 308-2168.

ekn
9/27/01

Eric K. Nicholson
Primary Examiner
Technology Center 3600

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in ABANDONMENT of the application.